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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/553,804

12/01/2005

Tom Jacobsen

05139

6086

23338 7590 12/12/2008  
DENNISON, SCHULTZ & MACDONALD  
1727 KING STREET  
SUITE 105  
ALEXANDRIA, VA 22314

EXAMINER

BEACH, THOMAS A

ART UNIT

PAPER NUMBER

3671

MAIL DATE

DELIVERY MODE

12/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/553,804	<b>Applicant(s)</b> JACOBSEN ET AL.	
	<b>Examiner</b> THOMAS A. BEACH	<b>Art Unit</b> 3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 09/29/08.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 14-20, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-20, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “locking member”, “first and second coupling members” and “the rotational and axial movement of first and second coupling members” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 14-17 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobsen et al 6,966,132 in view of Flesen 6,145,223. Jacobsen shows apparatus for removal of cuttings from a borehole (col. 1, lines 13-15) with the use of an ejector, having a first unit in the form of an ROV (1) with a rigidly attached ejector pump (12) provided with a connecting hose (unnumbered hose leading to 11) terminated at an opposite end in a first coupling part (11) provided with a second coupling part (unnumbered part of 5 that connects 11 to 5), a second unit comprising an ejector (7) attached a suction portion to a suction hose (8), said first coupling part (unnumbered connection of 11 to 5), but does not show the use of a selective rapid coupling means including a locking member operable for locking and unlocking the first and second coupling parts by at least one of a rotational and axial movement which can be performed by an ROV. However, Flesen shows a similar apparatus for removal of cuttings from a borehole with the use of an ejector 34 and ROV 26 having a first coupling means with first and second coupling parts and the connecting hose between ejector 34 and connecting hose 40 that includes selective coupling arrangement (fig 2; claim 21) capable of being rapidly connected by an ROV. Therefore, it would have

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been obvious to one of ordinary skill in the art at the time the invention was made to modify Jacobsen, as taught by Flesen, to include selective coupling arrangement for the predictable benefit of easily connection and replacement of hose elements if selectively coupled. Furthermore, the combination may not show the use of a selective rapid coupling means including a locking member operable for locking and unlocking the first and second coupling parts by at least one of a rotational and axial movement which can be performed by an ROV. However, applicant has stated on page 4, lines 5+, that this arrangement is not important, thus not patentably distinct, in which the Examiner takes official notice that it is well know in the art.

As concerns claim 15, the combination shows the suction hose has an inlet end opposite to the ejector comprising a first coupling part of a second coupling, arranged to be selectively connected to a second coupling part of the second coupling of a guide base at a borehole.

As concerns claim 16, the combination shows the ejector pump (Jacobsen, 12) supplying the ejector (7) with water, is powered by the power supply (3) for the ROV (Jacobsen, 1).

As concerns claim 17, the combination shows the ejector (Jacobsen, 7) is arranged at the outlet end of the suction hose (Jacobsen, 5).

As concerns claim 19, the combination (Jacobsen) shows the suction hose (6) and the ejector (7) has a common, substantially constant cross section.

As concerns claim 20, the combination (Jacobsen) shows the outlet end of the ejector (7) is shaped with a gradually increasing cross section.

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4. Claims 18 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobsen et al 6,966,132 and Flesen 6,145,223 in view of Edvardsen 6,877,565. The combination shows the element of claims 22-23 as detailed above, but does not show a discharge hose or pipe connected to the outlet side of the ejector so that the sediment can be transported further away from the borehole or connected directly to a guide base around a borehole with a suitable coupling while the outlet side of the ejector is connected to a discharge hose, said remote operating unit 14 preferably being connected to the ejector by means of a particular extension hose. However, Edvardsen shows a similar apparatus for removal of cuttings from a borehole (16) with the use of an ejector a discharge hose 22 or pipe 22 connected to the outlet side of the ejector so that the sediment can be transported further away from the borehole or connected directly to a guide base around a borehole with a suitable coupling while the outlet side of the ejector is connected to a discharge hose, said remote operating unit 14 preferably being connected to the ejector by means of a particular extension hose (fig 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination, as taught by Edvardsen, to include the coupling to the borehole arrangement and hose for the predictable result of improved versatility of the apparatus for various uses.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments regarding Jacobsen,

Flesen and Edvardsen Applicant's arguments amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

6. Furthermore, applicant's arguments do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Finally, they do not show how the amendments avoid such references or objections.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Beach whose telephone number is 571.272.6988. The examiner can normally be reached on Monday-Friday, 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Will can be reached on 571.272.6998. The fax phone number for the organization where this application or proceeding is assigned is 571.273.8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thomas A. Beach

/Thomas A Beach/  
Primary Examiner, Art Unit 3671

December 13, 2008

**THOMAS A. BEACH**  
**Primary Examiner**  
**Group 3600**